REMARKS/ARGUMENTS

Claims 1-4, 6-18, and 20-30 were pending in this application. No claims have been amended, added, or canceled. Hence, claims 1-4, 6-18, and 20-30 remain pending. Reconsideration of the subject application as amended is respectfully requested.

Claims 1, 3, 8, 10-13, 15, 17, 22, 24-27, 29 and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the cited portions of U.S. Patent No 5,740,532 to Fernandez et al. (hereinafter "Fernandez").

Claims 9, 14, 23 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez.

Claims 2, 4, 6, 7, 16, 18, 20, and 21 are objected to but would be allowed if rewritten in independent form.

Claim Rejections Under 35 U.S.C. § 102(b)

The Applicants respectfully traverse the rejection of claim 1. In order for a claim to be anticipated, "the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." (MPEP §706.02) Fernandez does not teach all the claim 1 elements. Further, Fernandez does not suggest the elements.

For example, claim 1 includes the limitation, "transmitting the packetized announcement with the data for receipt by the destination upon sensing the predetermined trigger event." Fernandez does not appear to teach this. At the location that the office action says teaches this, Fernandez teaches how to determine whether a selective call receiver is capable of receiving a priority message (look-up table), and sending the message accordingly, which is not "transmitting the packetized announcement with the data for receipt by the destination upon sensing the predetermined trigger event." Thus, claim 1 is believed to be allowable, at least for this reason.

Claim 15 includes a similar limitation and is believed to be allowable for similar reasons. The remaining claims each depend from one of these independent claims and are believed allowable, at least for the reasons stated above.

Claim Rejections Under 35 U.S.C. § 103(a)

Further, the rejections of claims 9, 14, 23, and 28 are respectfully traversed since the office action has not established a *prima facie* case of obviousness.

> To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria. Specifically, the office action has not shown that the prior art teaches or suggests all the claim limitations, and the office action does not cite a reference that teaches or suggests a motivation to combine reference teachings.

With respect to the third prong of the test the office action correctly states that Fernandez does not teach at least one limitation for each claim. Without citing an alternative reference that teaches each limitation, however, the office action appears to take official notice that the limitation is found in the prior art. The Applicants note that

> [t]he examiner may take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being well-known in the art. ... If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state. ... If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.
>
> When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts **must be supported, when called for by the applicant, by an affidavit** from the examiner.

(MPEP § 2144.03, emphasis added, citing 37 CFR §1.104(d)(2)) If the office action is relying on facts within the personal knowledge of the Examiner, the Applicants respectfully traverse the

rejection and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by 37 CFR §1.104(d)(2). Since the office action has not cited a reference in the prior art that teaches all the claim limitations, the Applicants believe that claims 9, 14, 23, and 28 are allowable.

Further, the office action does not cite a reference in the prior art that provides the necessary motivation or suggestion to modify Fernandez to achieve the Applicant's claimed invention. The Applicants note that,

> [o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(MPEP § 2143.01) Once again it appears that the office action is relying on facts within the personal knowledge of the examiner, in which case the Applicants respectfully traverse the rejection and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by 37 CFR §1.104(d)(2). Thus, for this additional reason, claims 9, 14, 23, and 28 are believed to be allowable.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Irvin E. Branch
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
Attachments
IEB:al
60177449 v1